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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/890,554      | 08/02/2001  | Walter Keller        | 2633-PA78           | 4639             |

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EXAMINER

KESACK, DANIEL

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                       |  |
|------------------------------|--------------------------------------|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/890,554 | <b>Applicant(s)</b><br>KELLER, WALTER |  |
|                              | <b>Examiner</b><br>Dan Kesack        | <b>Art Unit</b><br>3624               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 February 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The amendment filed February 9, 2006 has been entered, and considered. Original claims 1-15 have been cancelled. New claims 16-29 are currently pending. The rejections are as stated below.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 18-20, 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 recites, "wherein the service provider automatically accesses the corresponding data records." As recited, "corresponding data records" lacks antecedent basis in the claim, and it is unclear as to what said data records are corresponding to, rendering the claim indefinite.

Claims 19 and 20 recite "wherein the percentages of costs incurred are updated..." As recited, "percentages of costs" lacks antecedent basis in claim 16, and it is therefore indefinite as to what "percentages" are intended in these claims.

Claim 24 recites "...wherein the fee data is held in a file that is available for viewing by the user in the service provider database." As recited, "fee data" lacks sufficient antecedent basis in claim 16 to render the claim clear and distinct. Also, the "service provider database" lacks sufficient antecedent basis in claim 16. For examining purposes, and for application of prior art, the "service provider database" has been interpreted as the fee database of the service provider, as recited in claim 16.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 16-21, 23, 24, 26, 28 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ginzboorg et al., U.S. Patent No. 6,047,051.

Claims 16, 28, Ginzboorg discloses a method and system for charging fees for third party services in a telecommunications system, wherein the service provider determines fee information on the total costs incurred during a continued connection, in real time, by using access to the fee database of the service provider and service agencies involved, and transmits the fee information automatically to the terminal of the user (column 6 lines 3-29), where access by the service provider to the fee database is carried out automatically by direct transmission of the costs by the service agencies involved, as a response to a specific inquiry by the user at the start of the connection (column 5 lines 52-62), and where the service provider transmits a forecast of cost for upcoming cost-intensive service in response to a cost inquiry on the part of the user (column 6 lines 13-29).

Claim 17, Ginzboorg teaches the fee data management being carried out in the fee database and all user-specific and service specific fee terms and user specific contract data are stored (column 12 lines 42-65).

Claim 18, Ginzboorg teaches the service provider automatically accessing data records in the fee database of the service agencies involved (column 6 lines 3-10).

Claim 19, 20, Ginzboorg teaches the percentages of costs incurred are updated automatically and by the service agencies involved (column 16 lines 12-36).

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Claim 21, Ginzboorg teaches the databases and the data transmitted are protected against misuse (column 6 lines 30-54).

Claim 23, Ginzboorg teaches the service provider transmitting an updated status to the user whenever a fee is updated (column 6 lines 3-10).

Claim 24, Ginzboorg teaches the fee data is held in the service provider database, and is available for viewing by the user (figures 4 and 6).

Claim 26, Ginzboorg teaches a software part working directly with the service provider's database being provided within the browser software at the user's terminal (column 5 lines 42-50).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 22 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginzboorg, as applied to claims 16-21, 23, 24, 26, 28 above.

Claims 22, 25, Ginzboorg fails to teach the user selecting the scope and detail of fee information to be delivered to the terminal, and formats comprising at least one less detailed display, and one more detailed display.

Official notice is taken that user defined displays of billing data, including less detailed and more detailed formats are old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to include the feature of a user-selectable detail level of transmitted fee data because users having different needs for fee data detail can select the information they require, creating a more convenient billing summery, and this is a desirable feature among those who receive such bills.

9. Claims 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginzboorg, as applied to claims 16-21, 23, 24, 26, 28 above, and further in view of Maine, U.S. Patent No. 5,673,256.

Claims 27, 29, Ginzboorg fails to teach the user requesting the usage of services or transmissions at a later point in time, and scheduling automatic transmissions for a time at which a more economical usage occurs.

Claims 27, 29, Maine teaches a service provider receiving and storing data at a present time, a user selecting the data to be transmitted to a communications device, wherein said data may include video, and the user designating a time to receive said data, the time being a most economical time (figures 6 and 7). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Ginzboorg to include the delayed transmission of video data, as specified by the user, because Maine teaches the costs of using a communication system with delayed delivery is lower, making it more beneficial to the user (column 2 lines 7-27).

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within



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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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HANI M. KAZIMI  
PRIMARY EXAMINER